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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,752	02/01/2005	Makoto Urushihara	263468US6PCT	9309
22850	7590	09/15/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KHAN, ASHER R	
			ART UNIT 2621	PAPER NUMBER
			NOTIFICATION DATE 09/15/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/522,752	URUSHIHARA ET AL.	
	Examiner	Art Unit	
	ASHER KHAN	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/06/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 4-7, 10-14 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/30/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claim 1, 15 and 17 under § U.S.C 103 have been considered but are moot in view of the new ground(s) of rejection.

In re page 11 lines 17-22, Applicants argue that one of the ordinary skill in the art would clearly understand that a computer program is stored on a "computer readable medium", this phrase is supported at least by paragraph 24 of the specification.

In response the Examiner respectfully disagrees. Paragraph 24 does not state a computer readable medium storing a computer program. Even though one in ordinary skill in the art would understand that a computer program is stored on a "computer readable medium" the specification does not have the support of " a computer readable medium including computer executable instructions,"

Allowable Subject Matter

1. Claims 4-7, 10-14 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Computer-readable medium is new matter because there is no support in the specification for it.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 15 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,835,668 to Yanagihara in view of U.S. Patent 5,793,927 to Lane and in further view of U.S. Patent 7,386,218 B2 to Temple et al. "Temple".

As to claims 1, 15 and 17, Yanagihara discloses an information processing apparatus comprising:
checking means for checking predetermined time information of content data recorded in a first format (Col. 4 lines 60-67);
setting means for setting, on the basis of said content data time information checked by said checking means, bit rates with which said content data is recorded from said information processing apparatus to a predetermined removable recording medium (Col. 5, lines 4-15; Col. 7, lines, 7-33); and

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recording control means for converting the format of said content data from said first format to a second format and recording the converted content data to said recording medium with said bit rates set by said setting means (Fig. 8; Col. 4, lines 60-67, Col. 5, lines 1-15; Col. 9, lines 50-62).

Yanagihara does not expressly disclose controlling a content providing device to reproduce at a faster speed than a normal speed of the content providing device.

Lane disclose controlling a content providing device (Fig. 1, 100) to reproduce at a faster speed than a normal speed of the content providing device (Col. 10, lines 11-18).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara with the teachings of Lane. Motivation to combine would have been to provide time information by fast forwarding so that transcoding can be performed efficiently.

Yanagihara and Lane as modified do not expressly disclose that only a portion of the content data recorded in the first format is checked by the checking means, said checking means comparing the predetermined time information from successive frames to determine start and end times for chapters of said content data.

Temple discloses that only a portion of the content data recorded in the first format (input format) is checked by the checking means (check whether analog or digital signal), said checking means comparing the predetermined time information (specified time interval or absolute time information) from successive frames to determine start

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and end times for chapters of said content data (creation of a new chapter)(Col. 3 lines 60-67; col. 4 lines 1-56).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara and Lane as modified with the teachings of Temple. Motivation to combine would have been to provide chapter creation method for creating chapter breaks that allow random access.

As to claims 2 and 18, Yanagihara, Lane and Temple as modified disclose everything claimed as applied in claim 1 above. Yanagihara further wherein said checking means checks a recording time of said content data recorded in said first format as said time information (Col. 4, lines 60-67; Abstract).

As to claims 3 and 19, Yanagihara, Lane and Temple as modified disclose everything claimed as applied in claim 1 above. Yanagihara further discloses wherein said content data is constituted by a moving image data and audio data corresponding thereto (Fig.1;Col. 1, lines 66-67, Col 2, lines 1-6); said setting means sets, as said bit rates, a first bit rate corresponding to said moving image data and a second bit rate corresponding to said audio data (Figs. 1,5; Col. 1 line 66-67, Col. 2, lines 1-6; Col. 5, lines 4-15;Col. 7, lines, 7-33); and said recording control means executes control so as to record said moving image data of said content data in said first bit rate set by said setting means and record said audio data in said second bitrate set by said setting means (Fig. 8;Col. 4, lines 60-67, Col. 5, lines 1-15; Col. 9, lines 50-62)

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6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,835,668 to Yanagihara in view of U.S. Patent 5,793,927 to Lane, in view of U.S. Patent 7,386,218 B2 to Temple et al. "Temple" and in further view of U.S. Patent Pub. 2003/0194008 A1 to Acharya et al "Acharya"

As to claim 8, Yanagihara, Lane and Temple as modified disclose everything claimed as applied in claim 1 above but Yanagihara, Lane and Temple as modified do not expressly disclose wherein said first format is a format of a digital video tape recorder and said second format is a format specified by the DVD standard.

Acharya discloses wherein said first format is a format of a digital video tape recorder and said second format is a format specified by the DVD standard (Fig. 3; 0001-0002; 0004)

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara, Land and Temple as modified with the teachings of Acharya. Motivation to combine would have been to convert digital video tape recording to DVD recording.

7. Claims 9 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,835,668 to Yanagihara in view of U.S. Patent 5,793,927 to Lane, in view of U.S. Patent 7,386,218 B2 to Temple et al. "Temple" in view of Japanese document JP 08-031044 to Mimura Yoshiaki "Mimura" and in further view of U.S. Patent Pub. 2006/0010136 A1 to Deangelo.

As to claims 9 and 16, Yanagihara, Lane and Temple as modified disclose everything claimed as applied in claim 1 above. Yanagihara further discloses further

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comprising: storage means for storing said content data, said recording control means (System is a recorder; Col. 3, lines 42 -45; Col. 4 lines 45 -49).

Yanagihara, Lane and Temple as modified do not expressly disclose computation means for computing a free capacity of said storage means; acquisition means for dividing said content data into a plurality of data sections on the basis of said free capacity of said storage means computed by said computation means, acquiring a predetermined first data section among said plurality of data sections, and storing said acquired predetermined first data section into said storage means; conversion means for converting said format of said first data section acquired by said acquisition means from said first format to a second format, generating a second data section smaller in data amount than said first data section, and storing the generated second data section into said storage means; deletion means for deleting, when said generated second data section obtained by converting said format of said first data section by said conversion means has been stored in said storage means, said first data section from said storage means before a third data section different from said first data section is acquired by said acquisition means from among said plurality of data sections forming said content data; and recording medium recording control means for, if said content data has all been acquired in said acquisition means, converted into said second format in said conversion means, and stored in said storage device, recording the content data of said second format to said recording medium at said bit rate set by said setting means.

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Mimura discloses computation means for computing a free capacity of said storage means (0007-0008; measuring of residue of 2nd magnetic tape); acquisition means for dividing said content data into a plurality of data sections on the basis of said free capacity of said storage means computed by said computation means, acquiring a predetermined first data section among said plurality of data sections, and storing said acquired predetermined first data section into said storage means (0007-0008) conversion means for converting said format of said first data section acquired by said acquisition means from said first format to a second format (Long time to standard or standard to long; Claim 3), generating a second data section smaller in data amount than said first data section, and storing the generated second data section into said storage means (claim 1; Long time to standard time); and recording medium recording control means for, if said content data has all been acquired in said acquisition means, converted into said second format in said conversion means, and stored in said storage device, recording the content data of said second format to said recording medium(0007-0012).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara, Lane and Temple as modified with the teachings of Mimura. Motivation to combine would have been to transfer data from one medium to other in a set portion so that all the media could be transferred from one medium to other.

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Yanagihara, Lane, Temple and Mimura as modified do not expressly disclose deletion means for deleting, said first data section from said storage means before a third data section different from said first data section is acquired by said acquisition means from among said plurality of data sections forming said content data.

Deangelo disclose deletion means for deleting, said first data section from said storage means before a third data section different from said first data section is acquired by said acquisition means from among said plurality of data sections forming said content data (0140)

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Yanagihara, Lane, Temple and Mimura as modified with the teachings of Iwatsu. Motivation to combine would to delete what has been recorded already and copying or recording new contents into a storage.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (571)272-7905. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/
Supervisory Patent Examiner, Art Unit 2621

/A. K./
Examiner, Art Unit 2621